REMARKS

<u>SUMMARY OF 02/06/2009 OFFICE ACTION:</u>

The subject application includes prior claims 53 through 62, with claims 53 and 58 being independent claims. All claims 53-62 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Published Patent Application No. 2002/0037766 (Muniz). All claims 53-62 were alternatively rejected under 35 U.S.C. § 102(b) as being anticipated by Muniz with further evidence provided by Powerball.

<u>AMENDMENTS:</u>

Presently submitted amendments to claims 53, 57, 58 and 62 make minor adjustments that help clarify such claims. In particular, each of claims 53, 57, and 62 inadvertently made reference to a "drawn set" where such element should more appropriately be referred to as the "drawn <u>sub</u>set." Claim 57 inadvertently left out the word "comparing" in one of its recited steps. Claims 53 and 58 referred to the number of game indicia in the combined spot entry as "N," when it clearly should have been "the total spot entry." In addition, claims 53 and 58 are amended to more particularly distinguish such claims from k/N lotteries and Powerball games that are discussed in the recent Office Action.

<u>DISTINGUISHING COMMENTS:</u>

Present claims 53-57 are directed to a method for conducting a wagering game while claims 58-62 are directed to a gaming system for conducting a similar wagering game, both of which are Keno style games. As described in the subject application in

paragraph [0037], a standard Keno game involves the random drawing of 20 numbers (e.g., a drawn subset as set forth in claim 53) from a field of numbers ranging from 1 to 80 (e.g., a set of game indicia as set forth in claim 53). Players may choose how many numbers they wish to play, typically from 1 to 10 numbers. This quantity of numbers, or "spot" selected by a player determines the type and name of the game. For example, if a player selects five numbers, the player is playing a 5-spot game in which a comparison is made between the player's 5 numbers and the drawn subset (e.g., the randomly drawn 20 numbers).

Claim 53 is a variation on a standard Keno game because there are multiple opportunities to win within a single wagering game. In the method of claim 53, a similar set of game indicia may be provided (e.g., a field of numbers from 1 to 80). A player is given the option to select how many numbers they want to play (i.e., the player spot entry) from a range of 1 to 1 less than a defined total spot entry. In one example, if the total spot entry is 11, then the player can select his spot entry in a range of 1-10 (e.g., 5 "player spot entry" game indicia). Again, a subset of indicia (e.g., 20 numbers) is drawn from the set of game indicia (e.g., the field of 80 numbers).

Referring still to the game of claim 53, two separate comparisons (and two corresponding possible prize awards) are then made to determine whether or not a user has won the wagering game. A first comparison involves comparing the game indicia of the drawn subset (i.e., the 20 randomly drawn numbers) to the game indicia in the player spot entry (i.e., the 5 player spot entry game indicia). The level of correspondence in this first comparison determines whether a first prize award is due. A second comparison involves comparing a new group of spot entry game indicia to the drawn subset (i.e., the 20 randomly drawn numbers). This new group (the combined

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spot entry) includes a number of indicia equal to the total spot entry (e.g., 11) and includes all 5 of the player spot entry game indicia as well as 6 randomly generated supplemental spot entry game indicia. The level of correspondence in this second separate comparison of the combined spot entry indicia (e.g., 11 total identified game indicia) to the drawn subset (e.g., 20 randomly drawn numbers) determines whether a second prize award is due.

The cited Muniz reference discusses several different types of lottery games, none of which fit within the specific contours of claim 53. Since Applicants already identified the many differences between claim 53 and a basic Powerball game (such as shown in Fig. 5a of Muniz) in their most previous amendment and response, the following discussion will primarily address the differences between claim 53 and the k/N lotteries discussed in Muniz, for example in paragraphs [0071]-[0076].

The k/N-type lotteries disclosed in Muniz are generally played by providing a matrix of N numbers (e.g., 99 numbers as shown in Fig. 9 of Muniz) and letting a player pick a number k (e.g., 6) selections from the matrix of N choices. The number k determines the function as well as the name of the lottery game. For example, a lottery with a requirement to pick six numbers from a matrix may be termed a "pick 6 lottery." A plurality of k winning numbers are then selected from the same matrix, and the k winning numbers are compared to the player's selection of k numbers. For example, in a pick 6 lottery, a player who matches all six of their numbers to the six drawn numbers wins a top prize, and other prizes may be available for partial matching. (See paragraph [0060] of Muniz.) Sometimes, additional numbers can be chosen by a player, so that a player gets even more chances to match the k drawn winning numbers. For example, in a 6/N lottery,

instead of selecting only 6 numbers a player may pay an additional amount to select a total of 15 numbers.

The February 6, 2009 Office Action equates the k/N-type lottery disclosed in Muniz with the method of conducting a wagering game set forth in claim 53. Referring to Table A in Muniz, it appears that such comparison attempts to equate the player spot entry of claim 53 with a bottom limit (k) of player numbers in a k/N lottery. The top limit (k + some additional number) is then compared to the combined spot entry such that the supplemental spot entry is equal to the top limit minus the bottom limit. For example, consider a 6/N lottery where six player selections comprise the player spot entry and nine player selections comprise the supplemental spot entry, resulting in a combined spot entry having a total number of fifteen selections.

If this comparison between claim 53 and the k/N lottery of Muniz is what was intended, Applicant notes that several limitations of claim 53 cannot be met by the k/N lottery of Muniz. First, the number of indicia in the randomly drawn subset defining winning numbers is never "at least equal to the total spot entry for the game" as required by claim 53. Second, the Muniz k/N lottery game does not include the first and second separate comparing steps as set forth in claim 53.

Concerning the first difference between claim 53 and Muniz's k/N lottery game, Applicants note that claim 53 specifically requires that "the number of indicia in the randomly drawn subset is greater than the total spot entry for the game." In the k/N lottery where additional numbers are chosen (e.g., 15 numbers in a pick 6 lottery), the number of indicia in the randomly drawn subset is 6, but the total spot entry is 15. As such, the number of indicia in the randomly drawn subset of Muniz's k/N lottery with additional numbers chosen is always less than or equal to the total spot entry, not greater than the

total spot entry as required by claim 53. Even if only 6 numbers were chosen (causing the number of indicia in the randomly drawn subset to be equal to the total spot entry), then not only would the relationship between these two sets still fail, but the supplemental spot entry can no longer exist such that the player spot entry is within the range of from 1 to 1 less than the total spot entry. The comparison of Muniz's k/n lottery to claim 53 fails because there is a fundamental difference in the number of player-chosen indicia as related to the number in the drawn subset of winning indicia.

Concerning the second difference between claim 53 and Muniz's k/N lottery, Applicants note that there is only a single comparison to determine a prize award made in a k/N lottery game. In a 6/N game as described in Muniz, a player must decide up front if he wants to pick 6 or pick a higher amount of numbers (e.g., 15) for an extra fee. Once that decision is made, the identified number of choices picked by a player is compared in a single comparing step to 6 drawn winning numbers. There are not separate games played by first comparing a subset of the player-chosen numbers to the drawn winning numbers and then comparing the entire set of the player-chosen numbers to the drawn winning numbers. As such, Muniz's k/N lottery game fails to set forth separate steps as called for in claim 53 of first "comparing the game indicia of the drawn subset to the game indicia of the player spot entry" and secondly "comparing the game indicia in the combined spot entry to the game indicia of the drawn subset."

Numbered page 3 of the February 6, 2008 Office Action sets forth that "the art inherently teaches offering a greater prize for selecting all winning 6 numbers compared to selecting 15 numbers and containing the winning 6 numbers within this set." However, it is critical to note that the choice to play 6 numbers versus 15 numbers is made up front by a player of the 6/N lottery game. If the player picks 6, then a single comparison is made

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between his 6 chosen picks and the 6 drawn winners. If the player picks 15, then a single comparison is made between his 15 chosen picks and the 6 drawn winners. There are not two separate comparisons made between the user picks (a subset and the entire set) and thus separate options of winning a first prize and/or a second prize as called for in claim 53.

The Office Action proceeds to compare claim 53 to the common method of playing a Powerball lottery game, where a player selects five out of 49 numbers (equated to a player spot entry) as well as one red ball number (equated to a supplemental spot entry) all from the same matrix, as suggested in paragraph [106] of Muniz. Even in this variation of Powerball, the method of conducting a wagering game as set forth in claim 53 is different for several reasons.

First, Powerball games do not provide players with an option of selecting the number of game indicia equal to a player spot entry, where the player spot entry has a defined relationship to the total spot entry and supplemental spot entry. Instead, the PSE or "N" value is fixed in such Powerball games. For example, in conventional Powerball games, a player is required to select a given number (e.g., 5) of picks out of a total number (e.g., 49) of possible number choices. The player does not have the option of playing the game based on only 1, 2, 3 or 4 numbers. And even if this player spot entry was not fixed, the 5 selectable numbers in Powerball are not a function of a total spot entry designated for the game, wherein the total spot entry corresponds to a defined number of the game indicia that is less than 49, and wherein the player's selection is limited to a range of from 1 to less than the total spot entry. In other words, in the Powerball game, if the total spot entry is set at 6 (five regular choices and a red

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powerball choice), a player does not have the option to play the game based on only 1, 2, 3, 4 or 5 numbers.

Second, Powerball games do not include claim 53's step of randomly generating a supplemental spot entry for the player from the same set of game indicia, wherein the supplemental spot entry has a number of game indicia corresponding to the total spot entry minus the number "N" of game indicia in the player spot entry. If the single red powerball selection is equated with the supplemental spot entry of claim 53, Applicants again note that the red powerball selection corresponds to selecting a fixed number of choices (i.e., "Pick 1") as opposed to a number of game indicia determined by "the total spot entry minus N." It should be clear that the specific relationships relating the player spot entry, supplemental spot entry and total spot entry as set forth in claim 53 are completely missing from the Powerball game configuration.

A third difference between Powerball-type games and claim 53 again involves the requirement that the number of indicia in the randomly drawn subset is greater than the total spot entry for the game. If the regular "pick 5" of Powerball is compared to the player spot entry of claim 53, and the single "pick 1" red Powerball selection is compared to the supplemental spot entry, this results in a total spot entry of six game indicia. In powerball, the number of randomly drawn winning numbers is also always 6 which means that the total spot entry of 6 is equal to the number of indicia in the randomly drawn subset within a Powerball game. Since Powerball does not involve drawing 7 or more numbers when only 6 total numbers are selected as player picks, Powerball games cannot satisfy the limitation of claim 53 that the number of indicia in the randomly drawn subset is greater than the total spot entry.

Applicants respectfully submit that the enhanced game set forth in independent claim 53 is fundamentally different from the k/N-type lottery game disclosed in Muniz as well as a conventional Powerball game. In addition, there is no other reference of record that would suggest, teach, or otherwise motivate or provide any logical reason for one skilled in the art to modify the k/N lottery game of Muniz or a conventional Powerball game in accordance with the method of independent claim 53. Accordingly, applicant respectfully submits that independent claim 53 patentably distinguishes over Muniz and the Powerball game alone or in combination with any other reference of record. Claims 54 through 57 only further patentably define the method of claim 53, and are thus also allowable.

Independent claim 58 is drawn to a unique system for conducting a wagering game as described above with respect to independent claim 53. The relevant distinguishing limitations of the gaming method are incorporated into the gaming system of claim 58, and applicant respectfully submits that claim 58 is allowable for at least the reasons set forth above with respect to claim 53.

With further regard to claims 56 and 61, Applicant notes that Muniz's disclosure of picking 15 numbers to play a "pick 6" game does not satisfy an embodiment having a number of game indicia in the range of about 80, a number of game indicia in the total spot entry of 11 and a number of indicia in the drawn subset of 20. Again, it is clear from this specific numerical embodiment that the number of indicia in the drawn subset (20) is greater than the number of indicia in the total spot entry (11) since 20>11. This is completely backwards from Muniz's game of picking 15 numbers in a "pick 6" game, where the number of indicia in the drawn subset (6) is less than the number of indicia in the total spot entry (15). As such, even if Muniz was modified to include 80 possible

game indicia and 20 game indicia in a drawn subset, the total spot entry would have to be greater than 20 based on the definition of a k/N lottery game, and thus could never be 11.

CONCLUSION:

With the present Amendment, applicants respectfully submit that all pending claims are allowable, and that the application is in condition for allowance. Favorable action thereon is respectfully requested. The Examiner is encouraged to contact the undersigned at his convenience should he have any questions regarding this matter or require any additional information.

Respectfully submitted,

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